



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,446	04/20/2004	Kazumi Minoguchi	0051-0226PUS1	2718
2292 7590 02/07/2011 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
SEVERSON, RYAN J				
ART UNIT		PAPER NUMBER		
3731				
NOTIFICATION DATE		DELIVERY MODE		
02/07/2011		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/827,446

Applicant(s)

MINOGUCHI ET AL.

Examiner

RYAN J. SEVERSON

Art Unit

3731

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-10 and 17-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18 is/are rejected.
- 7) ☒ Claim(s) 6-10, 17 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-945)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claims 6-10 and 19 are objected to because of the following informalities: In line 10 of Claim 6, the claim recites, in part, "the plate shaped first tooth". Examiner believes this should read "the plate shaped first tooth-hardening member". Appropriate correction is required. Examiner notes here that claim 6 remains otherwise allowable for the reasons set forth in the previous rejection mailed 7/26/2010.
2. Claim 17 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 17 recites the hardness of the upper surface of the first tooth-hardening member differs from the hardness of the lower surface of the first tooth-hardening member and/or the upper and lower surfaces of the second tooth-hardening member have differing hardnesses. However, claim 6, from which claim 17 now depends, already recites these features (see lines 11-13 of claim 6). Therefore, claim 17 does not further limit claim 6.
3. Claim 18 is objected to because of the following informalities: In line 10, the claim recites, in part, "the plate shaped first tooth". Examiner believes this should read "the plate shaped first tooth-hardening member". Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over**

Nakata et al. (GB 2 288 126 A). Nakata et al. disclose an apparatus for a teething infant comprising an annular plate shaped first tooth-hardening member (42) having a top surface with projections (on either side of section 45, see figure 6) and plate shaped second tooth-hardening members (43 and 44) having a top surface with a plurality of projections (see figure 5). The second tooth-hardening members are arranged at an outer peripheral edge of the first tooth-hardening member (see figure 5). The second tooth-hardening members have top and bottom surfaces with differing hardnesses (see page 8, lines 32-34 where both surfaces are rubber). The first tooth-hardening member (grip portion) is made from a hard resin (see page 4, lines 24 and 25). Therefore, the top surface of the first member is harder than the top surface of the second member (because the resin is a hard plastic, which is harder than rubber). However, the embodiment shown in figure 5 as disclosed by Nakata et al. fails to explicitly disclose the second member is oval shaped. Attention is drawn to page 3, line 17 of Nakata et al., which teaches having a teething portion (analogous to the second members of figure 5) that is oval shaped. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have shaped the second

members of the embodiment shown in figure 5 of Nakata et al. in an oval shape in the manner taught by the embodiment described at page 3, line 17.

6. Further, it has been held that absent persuasive evidence that the particular configuration of the claimed second tooth-hardening members is significant, a person of ordinary skill in the art would have found it obvious to shape the prior art second tooth-hardening members in the claimed shape/configuration. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966)

Allowable Subject Matter

7. Claims 6-10 and 19 would be allowable if amended to overcome the claim 6 objection set forth above in this Office action. Examiner considers this correction a formality and would not necessitate further consideration and search if the amendment is provided after-final (i.e. an amendment after-final to correct this objection would be entered).

Response to Arguments

8. Applicant's arguments filed 11/23/2010 have been fully considered but they are not persuasive.

9. Applicant argues element 42 of Nakata et al. is not plate-shaped, as claimed. However, Examiner is unaware of any inherent structure required by the term "plate-shaped". Further, the specification does not provide a special definition for the term. Examiner contends that since element 42 lines in a single plane, it can be considered plate-shaped.

10. Applicant argues one skilled in the art would not have modified the embodiment shown in figure 5 of Nakata et al. with the embodiment shown in figure 1. Applicant states that figure 1 shows the teething element 11 is not oval. However, the specification of Nakata et al. explicitly recites the term "oval". Therefore, this is a proper teaching that it is known to have oval teething elements, regardless of the perceived shape of the teething element shown in figure 1.

Further regarding the combination of the two embodiments of Nakata et al., Examiner reminds applicant that the rejection above was not to literally remove the teething elements (43 and 44) of figure 5 and replace them with the teething element (11) of figure 1. Rather, the rejection takes the position that a skilled artisan would have found it obvious to have shaped the already existing teething elements (43 and 44) as an oval in view of the explicit disclosure of Nakata et al. Because of this, there is no reason the rejection should set forth how the two sets of teething elements would be literally swapped and attached to the first tooth-hardening members. Applicant is reminded that the test for obviousness is not whether the features of a secondary reference (in this case, the embodiment of figure 1) may be bodily incorporated into the structure of the primary reference (in this case, the embodiment of figure 5); nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Applicant argues the teething element 43 is not at a peripheral edge of the teething element 44. However, Examiner never suggested this was the case. The teething elements 43 and 44 of Nakata et al. are considered the "plate shaped second tooth-hardening members" (note here that *members* is plural) and that they are arranged at a periphery of an annular plate-shaped first tooth-hardening member.

Regarding the *In re Dailey* case law, Examiner notes this was not cited as an admission of the weakness of the rejection or used as a *per se* rule. Rather, it was a supplemental piece of evidence in addition to the disclosure of Nakata et al. used to show that the claim 18 limitations would have been obvious to a skilled artisan. Applicant has not provided any evidence that having the second tooth-hardening members in an oval shape is critical or for any specific purpose.

In any event, even if applicant disagrees with the application of *In re Dailey*, there still exists a rejection based solely on the prior art teachings as set forth above (see paragraph 5) and in the previous rejection.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
12. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to RYAN J. SEVERSON whose telephone number is (571)272-3142. The examiner can normally be reached on Monday - Friday 8:30-5:00.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.